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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/522,322 | 03/09/2000 | Scott Faber | 004704.P002 | 2806 |

7590 03/12/2004

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EXAMINER

MEINECKE DIAZ, SUSANNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3623

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,322

Applicant(s)

FABER ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Final Office action is responsive to Applicant's amendment filed January 20, 2004.

Claim 1 has been amended.

Claims 1-56 are pending.

2. The previously pending Double Patenting rejections are obviated by Applicant's submission of terminal disclaimers.

Terminal Disclaimer

3. The terminal disclaimers filed on January 20, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration dates of U.S. Patent Nos. 6,223,165; 6,523,010; 6,546,372; and 6,549,889 have been reviewed and are accepted. The terminal disclaimers have been recorded.

Response to Arguments

4. Applicant's arguments filed January 20, 2004 have been fully considered but they are not persuasive.

Applicant argues the following in regard to the "Rent-An-Expert" article:

Applicants respectfully submit that none of the cited references teach the limitation of the "user selecting to receive the information" and the information being delivered in response to such a selection, as claimed...The customer then selects one of the bids. Note that the customer is not selecting to receive the information, but is first inputting a

problem and then selecting an expert who "seems to offer the best prospects for providing the necessary assistance."
(Page 12 of Applicant's response)

The Examiner respectfully disagrees. By selecting a desired expert, the user is inviting the expert to provide him/her with information pertinent to the user's problem. Applicant makes a similar assertion regarding the reference "Applying Technology News" and Examiner submits a similar response. By submitting a question to a search engine (as taught in "Applying Technology News"), it is understood that the user submitting the question is in search of an answer to this question. This desired answer results from the user's selection to receive information (i.e., an answer).

On page 13 of Applicant's response, Applicant argues that there is no motivation to combine the Expertcity references ("Rent-An-Expert On the Web" and "Expertcity.com Launches Premier Online Marketplace for Expert Services") with the reference describing answers.com ("Applying Technology News") because Expertcity.com allegedly teaches away from answers.com. While the Examiner acknowledges that Expertcity.com matched users with live experts and answers.com matches users with desired information through an information broker, both systems are directed toward the similar concept of matching users to sources of desired information, as explained in the art rejection.

Furthermore, the information provided through answers.com ultimately comes from an expert who is deemed capable of supplying the desired information and whose knowledge has been stored electronically. The Examiner asserts that one of ordinary skill in the art at the time of Applicant's invention would have appreciated the similarities

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between Expertcity.com and answers.com and been motivated to combine various aspects of the two systems to yield the claimed invention for the reasons outlined in the art rejection. For example, the art rejection states:

...Answers.com makes up for this deficiency in its teaching of an information broker that "uses a combination of published information, proprietary databases, and electronic data from qualified people who provide their own personal knowledge" ("Applying Technology News": ¶ 3) to provide paying customers with answers to their submitted inquiries ("Applying Technology News": ¶ 2). ***Answers.com meets the similar information needs met by Expertcity.com, albeit in a more delayed fashion that enables more research to be conducted when needed to answer a difficult question. Expertcity.com lays the framework for quickly and automatically supplying similarly requested information in a computer network;*** therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Expertcity.com's framework to supply customers with desired information from a database (as opposed to a live expert source) ***in order to attract a wider base of customers, such as those who need complex information that requires more research to be conducted in order to glean a more thorough and accurate response.*** (Emphasis added)

In conclusion, Applicant's arguments are found to be non-persuasive and the standing art rejection is maintained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Expertcity.com's Internet service, as disclosed in "Expertcity.com Launches Premier Online Marketplace for Expert Services" (which states that the Expertcity.com web site was launched on August 30, 1999) and "Rent-An-Expert on the Web," in view of answers.com, as disclosed in "Applying Technology News."

Expertcity.com discloses a system for delivering information, the system comprising:

[Claim 1] a communications interface ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11); and a controller computer being linked with the communications interface ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11), the controller computer having:

a server to display information provided by an information provider ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

a first logic unit linked with the server to establish via the communications interface a first communication connection with the information provider over which the information provider communicates the information ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11); and

a second logic unit linked with the server to establish, in response to a user selecting to receive the information and via the communications interface, a second communications connection with the user and to deliver the information via the second communications connection to the user (“Rent-An-Expert on the Web”: ¶¶ 3, 4; “Expertcity.com Launches Premier Online Marketplace for Expert Services”: ¶ 11);

[Claim 2] wherein the server further stores a description of the expertise of each information provider (“Expertcity.com Launches Premier Online Marketplace for Expert Services”: ¶¶ 1, 4);

[Claim 3] wherein the controller computer further has a third logic unit linked with the server to establish a computer connection with an information provider computer and to receive via the computer connection the description from the information provider (“Rent-An-Expert on the Web”: ¶¶ 3, 4; “Expertcity.com Launches Premier Online Marketplace for Expert Services”: ¶¶ 1, 4);

[Claim 4] wherein the computer connection is established through a web site accessible by the information provider computer (“Rent-An-Expert on the Web”: ¶¶ 3, 4);

[Claim 5] wherein the controller computer further has a third logic unit linked with the server to establish a computer connection with a user computer and to deliver the description to the user computer via the computer connection (“Rent-An-Expert on the Web”: ¶¶ 3, 4; “Expertcity.com Launches Premier Online Marketplace for Expert Services”: ¶¶ 1, 4);

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[Claim 6] wherein the computer connection is established through a web site accessible by the user computer ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 7] wherein the description includes a price for the information ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6);

[Claim 8] wherein the price includes a rate per period of time ("Rent-An-Expert on the Web": ¶¶ 4, 6);

[Claim 10] wherein the first communications connection includes a video connection ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 11] wherein the first communications connection is established over a computer network ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 14] wherein the second communications connection includes a video connection ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 15] wherein the second communications connection is established over a computer network ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 17] wherein the controller computer has a third logic unit to bill the user for the information ("Rent-An-Expert on the Web": ¶ 6);

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[Claim 18] wherein the controller computer has a fourth logic unit to track how long the information is delivered to the user and the third logic unit bills the user based upon how long the information is delivered ("Rent-An-Expert on the Web": ¶ 6);

[Claim 19] wherein the database further stores information about a user account ("Rent-An-Expert on the Web": ¶ 6 -- A credit card transaction utilizes a type of user account from which an amount is deducted, i.e., a transaction is charged against the user's available credit);

[Claim 20] wherein the controller computer has a third logic unit to deduct an amount from the user account for the information ("Rent-An-Expert on the Web": ¶ 6 -- A credit card transaction utilizes a type of user account from which an amount is deducted, i.e., a transaction is charged against the user's available credit);

[Claim 21] wherein the controller computer has a third logic unit to track how long the information is delivered to the user and a fourth logic unit to deduct from the user account an amount based upon how long the information is delivered ("Rent-An-Expert on the Web": ¶ 6 -- A credit card transaction utilizes a type of user account from which an amount is deducted, i.e., a transaction is charged against the user's available credit);

[Claim 23] wherein the controller computer has a third logic unit to credit an amount to the account when the information is delivered to the user ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the experts are credited based on how long they assisted customers);

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[Claim 24] wherein the controller computer has a third logic unit to track how long the information is delivered to the user and a fourth logic unit to credit to the account an amount based upon how long the information is delivered ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the experts are credited based on how long they assisted customers);

[Claim 25] wherein the controller computer has a third logic unit to track how long the information is delivered to the user and a fourth logic unit to credit to the account an amount based upon how long the information is delivered minus a fee ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the experts are credited based on how long they assisted customers).

As per claims 1-25, Expertcity.com's server facilitates a connection between customers and experts who can provide them with desired information (e.g., knowledge from the live experts); however, Expertcity.com's information is "live" knowledge as opposed to the claimed information recorded and stored in a database. Answers.com makes up for this deficiency in its teaching of an information broker that "uses a combination of published information, proprietary databases, and electronic data from qualified people who provide their own personal knowledge" ("Applying Technology News": ¶ 3) to provide paying customers with answers to their submitted inquiries ("Applying Technology News": ¶ 2). Answers.com meets the similar information needs

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met by Expertcity.com, albeit in a more delayed fashion that enables more research to be conducted when needed to answer a difficult question. Expertcity.com lays the framework for quickly and automatically supplying similarly requested information in a computer network; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Expertcity.com's framework to supply customers with desired information from a database (as opposed to a live expert source) in order to attract a wider base of customers, such as those who need complex information that requires more research to be conducted in order to glean a more thorough and accurate response.

Regarding claims 9, 12, 13, and 16, Expertcity.com fails to expressly teach that the customers may connect audibly with an expert, such as through the use of telephone connections. However, Official Notice is taken that it is old and well-known in the art of communications to enhance Internet communications with voice capabilities so that two users connected via the Internet can converse with one another. Furthermore, many Internet users connect to the Internet through a modem that dials up to the Internet through a telephone line. These voice capabilities via the Internet (and ultimately through a telephone line) reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone). Expertcity.com performs the generic functionality (e.g., connecting the customers to experts) of claims 9, 12, 13, and 16 (see "Rent-An-Expert on the Web": ¶¶ 3, 4, 6; "Expertcity.com Launches Premier Online Marketplace for

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Expert Services": ¶ 11). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Expertcity.com's generic functionality (e.g., connecting the customers to experts) corresponding to claims 9, 12, 13, and 16 with voice capabilities so that two users connected via the Internet can converse with one another through telephone lines in order to reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone).

As per claim 22, Expertcity.com pays out a percentage of income to the service providers ("Rent-An-Expert on the Web": ¶ 6); however, it fails to explicitly teach that the database further stores information about an account set up for the information provider. Official Notice is taken that it is old and well-known in the art to set up electronic payroll accounts for employees. Such accounts facilitate quick salary payments from an employer to their employees. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide Expertcity.com's experts with electronic payroll accounts through Expertcity.com's expert system in order to facilitate quick salary payments from Expertcity.com to its employed experts.

[Claims 26-40] Claims 26-40 recite limitations already addressed by the rejection of claims 1-25 above; therefore, the same rejection applies.

Furthermore, as per claims 30-32, Expertcity.com teaches that a customer can “obtain real-time, personalized expertise on a wide range of subjects from solving computer problems to assistance with personal finance. Customers can select from a roster...” (“Expertcity.com Launches Premier Online Marketplace for Expert Services”: ¶ 1). In other words, Expertcity.com teaches that the expert descriptions are included in a list of information providers, as per claim 30. However, Expertcity.com does not expressly teach that the list of information providers is delivered to the user in response to a keyword search (claim 31) or a category selection (claim 32). Official Notice is taken that it is old and well-known in the art of data selection to narrow down desired search results by either utilizing a keyword search or a category selection. Both practices facilitate speedier retrieval of specifically desired information, especially when one must search through a large amount of data. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to enhance Expertcity.com with the ability to perform keyword searches (claim 31) and category selection (claim 32) to identify experts from a collection of experts in order to facilitate speedier retrieval of specifically desired information (such as available experts specializing in a given field), especially when one must search through a large amount of data.

[Claims 41-56] Claims 41-56 recite limitations already addressed by the rejection of claims 1-40 above; therefore, the same rejection applies.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450

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or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

Susanna Diaz
Susanna M. Diaz
Primary Examiner
Art Unit 3623
March 10, 2004